

REMARKS

Applicants acknowledge with appreciation that the Examiner considers that all of the rejections made in the previous Office Action were overcome by the last response filed on December 8, 2003.

Claims 18, 19, 65, 67, 76, 82, and 84 are currently pending. All are now newly rejected under 35 U.S.C. § 112, first paragraph. Claim amendments were made to better define one embodiment of the invention, notwithstanding Applicants' belief that the unamended claims would have been allowable, without acquiescing to any of the Examiner's arguments, and without waiving the right to prosecute the unamended (or similar) claims in another application, for the purpose of furthering Applicants' business goals and expediting the patent application process in a manner consistent with the PTO's Patent Business Goals. None of the amendments to the claims is related to the statutory requirements of patentability unless expressly stated so herein.

Rejection under 35 U.S.C §112, first paragraph

Claims 18, 19, 65, 67, 73, 76, and 82-84 have been rejected under 35 U.S.C. § 112, first paragraph, on the ground that the specification, while being enabling for the treatment of certain types of cancer does not reasonably provide enablement for the treatment of cellular proliferative diseases in general. This rejection is respectfully traversed.

The test of enablement is whether the applicants have taught in their specification how to make and use the invention as claimed.

As a matter of Patent Office practice... a specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented *must* be taken as in compliance with the enabling requirement of the first paragraph of §112 *unless* there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support.¹

Further the court in *Marzocchi* has stated, "it is incumbent upon the Patent Office,

¹ *In re Marzocchi*, 439 F.2d 220, 223-24, 169 USPQ 367, 369-70 (CCPA 1971).

whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement.”²

While the Office Action has outlined subject matter which it acknowledges to be enabled and allowable, that subject matter is far more narrowly focused than that which is defined and described by the present specification and that which would be reasonably correlated by the skilled artisan.

More specifically, Applicants have described in detail in the specification how to make compounds in accordance with the invention, how to formulate such compounds into a variety of forms suitable for administration to mammalian subjects, and appropriate dosage schedules for such administration (see, for example, page 24, line 29 to page 25, line 8 and page 48, lines 9-14 of the instant specification).

Applicants have further provided guidance for selecting potent inhibitory agents using established *in vitro* assays (see, for example, the specification at page 44, line 5 to page 48, line 15) and have provided guidance for the specific cellular proliferative disorders, such as tumors, for which evidence exists that agents having the inhibitory activities of the compounds of the invention would be useful. In point of fact, the specification points out that the compounds of the invention inhibit growth in a variety of cell lines, including those which convey resistance to other chemotherapeutic drugs (see, for example, the specification at page 47, lines 18-23).

The Examiner has not provided any documentation or evidence as to why he doubts the truth or accuracy of Applicants’ assertions in this regard.

In view of the foregoing remarks, Applicants respectfully submit that the instant specification complies with the enablement requirements of 35 U.S.C. §112, first paragraph. However, without acquiescing to any of the Examiner’s arguments, but rather for the purpose of furthering Applicants’ business goals and expediting the patent application process, Applicants have amended the claims herein to focus on the embodiment drawn to methods of treating cancer. Applicants reserve the right to prosecute the originally filed claims in the future.

Accordingly, withdrawal of this new rejection hereunder is respectfully requested.

² MPEP 2164.04; *In re Marzocchi*, 439 F.2d 220, 169 USPQ 367 (CCPA 1971).

Conclusion

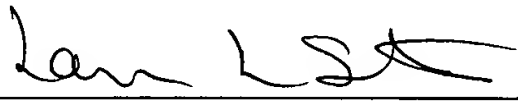
Applicants respectfully maintain that all pending claims are in condition for allowance. Therefore, Applicants respectfully request a Notice of Allowance for this application from the Examiner. Should any unresolved issues remain, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

Please grant any extensions of time required to enter this reply, and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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